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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
JP920010054US1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on July 12, 2006

Signature

Typed or printed name Louise Fay

Application Number	Filed
10/085,296	02/28/2002

First Named Inventor
Kawaguchi et al.

Art Unit	Examiner
3621	Winter, John M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [X] attorney or agent of record. Registration number 25,035
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

Gerald H. Glanzman
Typed or printed name

972-385-8777
Telephone number

July 12, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

[X] *Total of 1 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: **Kawaguchi et al.**	§	
	§	
Serial No.: **10/085,296**	§	Group Art Unit: **3621**
	§	
Filed: **February 28, 2002**	§	Examiner: **Winter, John M.**
	§	
For: **Method for Updating a License Period of a Program, Method for Licensing the Use of a Program, and Information Processing System and Program Thereof**	§	Attorney Docket No.: **JP920010054US1**
	§	
	§	

36736
PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS IN SUPPORT OF APPLICANTS' PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program.

No fee or extension of time is believed due for this request. However, if any fee or extension of time for this request is required, Applicants request that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to IBM Corporation Deposit Account No. 09-0461.

REMARKS

Applicants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action dated May 4, 2006. The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005.

In the Final Office Action, the Examiner rejects claims 3-6, 8, 11-14, and 16-18 under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Colosso* (U.S. Patent 6,169,976 B1) in view of *Hecksel et al.* (U.S. Patent 6,151,707), hereinafter referred to as *Hecksel*, and further in view of *Frison et al.* (U.S. Patent 6,049,789), hereinafter referred to as *Frison*, and further in view of *Horstmann* (U.S. patent 6,009,401). This rejection is respectfully traversed.

1. Teachings of Applicants' Invention

Applicants' invention is generally directed to a method and apparatus for automatically updating a license period of a program. A request for update is performed by referring to an index server. An address of the authentication server is encrypted in an index file from the index server so that the address is unpublished and hidden from a user. Claim 3, which is representative of the other rejected independent claims 11 and 17 with regard to similarly recited subject matter, recites the method of Applicants' invention as follows:

> 3. A method for updating a license period of a program; comprising:
> a first determination step of determining whether a current date and time is within a license period of the program;
> a step of issuing a request to an index server for transmission of an index file if a determination made by said first determination step is false;
> a step of receiving the index file from said index server;
> a step of issuing an authentication request to an authentication server with an address of the authentication server contained in said index file, wherein address information of said authentication server contained in said index file is encrypted, further comprising the step of decrypting the encrypted address information of said authentication server; (referred to hereinafter as "Feature (1)")
> a step of receiving authentication information from said authentication server;
> a second determination step of determining whether information indicative of success of authentication is contained in said authentication information; and
> a step of automatically updating the license period of said program if a determination made by said second determination step is true, wherein said first determination step is performed upon activation of said program, and wherein said program becomes executable after automatically updating said license period. (referred to hereinafter as "Feature (2)")

Claim 8, which is representative of the other rejected independent claims 16 and 18 with regard to similarly recited subject matter, recites the method of Applicants' invention as follows:

> 8. A method for licensing the use of a program, comprising the steps of:
> receiving a request from a user;

creating or selecting an index file containing address information of a server that grants authentication regarding a license of the program to be used by the user in response to receipt of the request, wherein said address information contained in said index file is encrypted; and (referred to hereinafter as "Feature (3)")

sending said index file to the user who issued said request.

It is seen that claims 3, 11, and 17 recite Features (1) –(2), respectively, and that claims 8, 16, and 18 recite Feature (3).

2. Feature (1) and Feature (3) Distinguish over Cited *Colosso*, *Hecksel*, *Frison*, and *Horstmann* References

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). For an invention to be prima facie obvious, the prior art must teach or suggest all claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Colosso, *Hecksel*, *Frison*, and *Horstmann*, either taken alone or in combination, do not teach or suggest Feature (1) as recited in claims 3, 11, and 17. Similarly, *Colosso*, *Hecksel*, *Frison*, and *Horstmann*, either taken alone or in combination, do not teach or suggest Feature(3) as recited in claims 8, 16, and 18.

Colosso is too far away from the present application to be a prior art anchor. *Colosso* is essentially a key management system. The customer obtains the software, either in a tangible form or by downloading over the internet. Then through interaction with the distributor and the licensor, the user obtains a key. The user then installs the software by manually entering the key when prompted for the key. The present invention is trying to solve the problem of manual user intervention.

Horstmann is directed to relicensing software that has been disabled after a trial period. Generally, the user has to manually obtain a key and then manually unlock the software using the key. The relicense method begins at the lock point after the trial period. The user has to initiate the licensing manager to start the relicensing process. The licensing manager then connects to a clearing house. However, rather than getting an index file containing an encrypted address of an authentication server, the licensing manager gets permission from the clearing house to relicense. *Horstmann* does not include the intermediate step of hiding the identity of the authenticator from the user. To the contrary, *Horstmann* actually teaches away from the independent claims since the licensing manager is installed on the end user's machine and the address of the clearing house is stored on the end user's machine.

3. **Features (2) Distinguishes over the Cited *Colosso*, *Hecksel*, *Frison*, and *Horstmann* References**

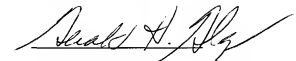
Colosso, *Hecksel*, *Frison*, and *Horstmann*, either taken alone or in combination, do not teach or suggest Feature (2) as recited in claims 3, 11, and 17. To the contrary, a user has to initiate the licensing manager to start the relicensing process. Claims 3, 11, and 17 recite automatically updating the license period of a program if a determination is made that the current date and time is not within a license period of the program upon activation of the program. The program becomes executable after automatically updating said license period.

In view of the above Remarks, Applicants submit that *Colosso*, *Hecksel*, *Frison*, and *Horstmann*, either taken individually or in combination, do not teach or suggest the features of independent claims 3, 8, 11, and 16-18. In addition, *Colosso*, *Hecksel*, *Frison*, and *Horstmann*, taken individually or in combination, do not teach or suggest the features of dependent claims 4-6 and 12-14 at least by virtue of their dependency on independent claims 3 and 11, respectively. Accordingly, Applicants' claims are patentable over the cited art and the application is in condition for allowance. Favorable action is respectfully requested.

The Pre-Appeal Brief Conference Panel is invited to call the undersigned at the below-listed telephone number if in the opinion of the Panel such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: July 12, 2006

Respectfully submitted,



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